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Sin Hui Cheah

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Joseph S Tripoli  
Thomson Multimedia Licensing Inc  
PO Box 5312  
Princeton, NJ 08540

EXAMINER

SELLERS, DANIEL R

ART UNIT

PAPER NUMBER

2614

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/030,766 | <b>Applicant(s)</b><br>CHEAH ET AL. |  |
|                              | <b>Examiner</b><br>DANIEL R. SELLERS | <b>Art Unit</b><br>2614             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9, and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 8/7/08 have been fully considered but they are not persuasive. Regarding claims 1, 4, 6, and 10, the examiner respectfully disagrees. The prior art of record teaches encrypting data and applications (see Truong, column 3, lines 13-16, lines 22-26, and lines 34-41). It is believed that when Truong teaches "decoding algorithms in encrypted form", Truong, in the parlance of the other art, is teaching decryption algorithms in encrypted form. Furthermore, in the combination, Truong teaches encrypting/decrypting programs, and this is believed to read on encrypting/decrypting the decoder (i.e. audio codec), which is used to decode the unencrypted audio. It should also be clear that the combination teaches encrypted/decrypted audio, or data.
2. The dependent claims 2, 3, 5, 7, and 9 are rejected for the same reasons as stated above and with respect to the rejections with respect to 35 USC 103 and 112 in the following.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. **Claims 1-7, 9, and 10** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The independent claims 1, 4, 6, and 10 appear to seek protection for new matter. Specifically, they seek protection for "using a security code... to generate a decryption program", wherein the generating step was not described. The generating step is thought to convey to one of ordinary skill in the art broader concepts than merely decrypting, whereas the specification has only disclosed "using the security code [to decrypt a decryption program]" (see figure 3, step 118 and p. 8, lines 9-10). The dependent claims 2, 3, 5, 7, and 9 are rejected because they depend from the independent claims incorporating new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-7, 9, and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 is amended to read "using a security code... to generate a decryption program", wherein the specification does not teach generation of a decryption program. The term generation appears to be broader than the disclosed "decryption of a decryption program" (see figure 3, step 118 and p. 8, lines 9-10).

8. Claims 4, 6, and 10 are amended similarly to claim 1 and are rejected for the same reasons.

9. Claims 2, 3, 5, 7, and 9 are rejected under 35 USC 112, because they depend from claims 1, 4, and/or 6.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-7 and 9-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaganas, Cho et al. (USPN 7,324,974), and Truong (hereinafter Kaganas, Cho, and Truong, respectively).

12. Regarding **claim 1**, in a handheld audio playback device, Kaganas teaches a method for playing back an audio data file, the audio data file being encoded in accordance with a selected one of a plurality of encoding formats, the method comprising the steps of:

*identifying a selected audio data file in response to a user input (column 2, lines 10-18, column 5, lines 4-14, and figure 1);*

*identifying a decoder file associated with the selected audio data file, the decoder file comprising a decoding program to control a decoding function of a digital signal processor (column 2, lines 35-62, column 5, line 65 - column 6, line 18, and column 6, lines 46-51);*

*transferring the selected audio data file and the associated decoder file to the digital signal processor, wherein the selected audio data file and the associated decoder file are both stored in a single removable data storage device coupled to the handheld audio playback device (column 6, lines 11-33);*

*using a security code associated with the handheld audio playback device to generate a decryption program;*

*decrypting the associated decoder file using the decryption program;*

*decrypting the selected audio data file using the decryption program;*

*decoding the selected audio data file in accordance with the decoder file in the digital signal processor (column 6, lines 18-30); and*

*providing the decoded audio data file to an output device (column 5, lines 31-36).*

Kaganas teaches a unique identification associated with a single removable data storage device. They teach decoder files, or programs, associated with different music (column 6, lines 11-18, and lines 46-51) and determining a unique identification associated with the removable data storage device coupled to the handheld audio playback device (column 4, lines 55-60). However, they do not teach the steps of generating a decryption program using a security code and decrypting the associated decoder and audio files using a generated decryption program.

Cho teaches an encryption method for protecting copyrighted audio files (abstract and figures 1-3). Specifically, Cho teaches decrypting the audio file using a decryption algorithm or program (see column 5, lines 54-57). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Kaganas and Cho for the purpose of protecting data files in transit from a host computer to a client computer (column 2, lines 30-40). However, neither Kaganas nor Cho teach encrypting or decrypting the associated decoder and decryption program.

Truong teaches a system for controlling access to information (column 1, lines 59-63). The teachings include securing a recording medium (Kaganas teaches a memory card, or MMC card) using a unique identification (column 3, lines 22-32), which is used to encrypt the audio (Cho, column 4, lines 22-40). The recording medium contains data (Kaganas teaches an audio data file) and/or applications (Kaganas teaches programs, or decoder files and Cho also teaches programs, or decoders and algorithms), and decoding these from encrypted form (Truong, column 3, lines 10-16

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and line 26). Truong teaches that the security table, which includes various decoding algorithms, is used to create the encoded information (column 3, line 26 and lines 34-36). The decoding utilizes the unique identification specific to the recording medium to decode the data (column 4, lines 24-58). The unique encrypted signature is based on information on the recorded medium (column 4, lines 44-45) and the keys associated with decrypting the associated data and programs are also based on values found in a security table (column 3, lines 25-26 and lines 34-36). This reads on “*using a security code associated with the handheld audio playback device to generate a decryption program*”, wherein the unique identification, as taught by Cho, is associated with a storage medium to create an encrypted signature (Cho, column 4, lines 10-21).

Furthermore it would have been obvious at the time by one of ordinary skill to encrypt the algorithm and decoder files to protect copyrights (implied that the various keys are used to encode/decode the various data and/or applications; see Truong, column 3, lines 13-16 and column 4, lines 6-10). It would have been obvious for one of ordinary skill in the art to combine the teachings of Kaganas, Cho, and Truong for the purpose of copy protection (column 1, lines 9-12). One of ordinary skill in the art at the time of the invention can appreciate that the protection of decoding programs and audio data files is more secure when different keys are used to protect the programs and files individually.

13. Regarding **claim 2**, the further limitation of claim 1, see Kaganas

*... further comprising the step of reading a configuration file that associates each one of a plurality of audio data files with a particular one of a plurality of decoder files, and the identifying the decoder file step comprises identifying the decoder file using the configuration file.*

Kaganas teaches the use of a plurality of codecs, and it is inherent that a codec is associated with a file format. Kaganas also teaches the use of an operating system for a plurality of uses, wherein they teach the use of Windows 95® when discussing e-mail and other communication features (column 3, lines 28-34). Popular operating systems maintain a list of programs associated with file types, such as ASCII text files. It is inherent that an operating system used for playback on the system of Kaganas maintains a configuration file regarding the association of codecs and audio data files.

14. Regarding **claim 3**, the further limitation of claim 2, see Kaganas

*... wherein the removable data storage device is a solid state data storage device. (column 7, lines 44-52)*

Kaganas teaches the use of solid state removable media.

15. Regarding **claim 4**, see the preceding argument with respect to claim 1.

Kaganas teaches a user input means (figure 1, unit 44), data input means (figure 1, unit 37), a digital signal processor (figure 1, unit 31), and a micro-controller with these features (figure 1, unit 32 and column 2, lines 10-13). The combination of Kaganas, Cho, and Truong teach the amended features.

16. Regarding **claim 5**, the further limitation of claim 4, see the preceding argument with respect to claim 3. Kaganas teaches the use of a solid-state data storage device that is removable.

17. Regarding **claim 6**, see the preceding argument with respect to claims 4 and 5. The combination of Kaganas, Cho, and Truong teaches a portable audio playback system with these features.



18. Regarding **claim 7**, the further limitation of claim 6, see the preceding argument with respect to claim 5. Kaganas teaches a removable solid-state storage device.

19. Regarding **claim 9**, see the preceding argument with respect to claim 2. Kaganas inherently teaches the use of configuration files with codec-file associations.

20. Regarding **claim 10**, see the preceding argument with respect to claim 1. The combination of Kaganas, Cho, and Truong teach these features.

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL R. SELLERS whose telephone number is (571)272-7528. The examiner can normally be reached on Monday to Friday, 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571)272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel R. Sellers/  
Examiner, Art Unit 2614

***/CURTIS KUNTZ/  
Supervisory Patent Examiner, Art Unit 2614***